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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,030	06/30/2003	Naoto Kudou	239706US0	7187

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1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PADEN, CAROLYN A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,030

Applicant(s)

KUDOU ET AL.

Examiner

Carolyn A. Paden

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 20-25 is/are rejected.
- 7) ☒ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>various</u> . | 6) <input type="checkbox"/> Other: _____ |

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17, & 20-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,635,777 in view of Nomura (5,160,759).

Kawai discloses an acid oil in water emulsifier composition containing 30-wt% or more of diglycerides and a yolk or enzyme treated yolk with specific amounts of lysophospholipids. The composition additionally contains phytosterols shown in claim 8. The chain length of the fatty acid residues in the diglycerides and the extent of diglycerides in the product required in claims 8-10 is shown at column 2, lines 19-47. The pH of the product would have been an inherent property of the composition and is

disclosed at column 3, lines 9-11. The claims appear to differ from Kawai in the recitation of the inclusion of a soybean polysaccharide in the Kawai emulsion. Kawai teaches at column 2, lines 63-65 the addition of a thickened polysaccharide to the emulsion. Nomura further describes polysaccharide for enhancing the stability of the emulsion. It would have been obvious to one of ordinary skill in the art to utilize polysaccharide in the claimed emulsion to enhance the stability of the product. It is appreciated that soy polysaccharide is not mentioned but no unobvious or unexpected result is seen from the selection of one polysaccharide source over another.

Claims 1-8, 11-17 & 20-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 10/459,512 in view of Nomura.

10/459,512 ('512 application) discloses an acid oil in water emulsifier composition containing 30-wt% or more of diglycerides and a yolk or enzyme treated yolk with specific amounts of lysophospholipids. The composition additionally contains phytosterols shown in claim 5. The chain length of the fatty acid residues in the diglycerides required in claim 8

would be expected from common or typical edible fatty acids. The pH of the product would have been an inherent property of the composition and is disclosed at page 7, lines 1-9. The claims appear to differ from Kawai application in the recitation of the inclusion of a soybean polysaccharide in the Kawai emulsion. Kawai application teaches at page 6, lines 11-15 the addition of a thickened polysaccharide to the emulsion. Nomura further describes polysaccharide for enhancing the stability of the emulsion. It would have been obvious to one of ordinary skill in the art to utilize polysaccharide in the claimed emulsion to enhance the stability of the product. It is appreciated that soy polysaccharide is not mentioned but no unobvious or unexpected result is seen from the selection of one polysaccharide source over another.

This is a provisional obviousness-type double patenting rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 & 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawai in view of Nomura

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Kawai discloses an acid oil in water emulsifier composition containing 30-wt% or more of diglycerides and a yolk or enzyme treated yolk with specific amounts of lysophospholipids. The composition additionally contains phytosterols shown in claim 8. The chain length of the fatty acid residues in the diglycerides and the extent of diglycerides in the product required in claims 8-10 is shown at column 2, lines 19-47. The pH of the product would have been an inherent property of the composition and is disclosed at column 3, lines 9-11. The claims appear to differ from Kawai in the recitation of the inclusion of a soybean polysaccharide in the Kawai emulsion. Kawai teaches at column 2, lines 63-65 the addition of a

thickened polysaccharide to the emulsion. Nomura further describes polysaccharide for enhancing the stability of the emulsion. It would have been obvious to one of ordinary skill in the art to utilize polysaccharide in the claimed emulsion to enhance the stability of the product. It is appreciated that soy polysaccharide is not mentioned but no unobvious or unexpected result is seen from the selection of one polysaccharide source over another.

Claims 1-8, 11-17 & 20-25 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/459,512 which has a common assignee with the instant application in view of Nomura. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

10/459,512 ('512 application) discloses an acid oil in water emulsifier composition containing 30-wt% or more of diglycerides and a yolk or enzyme treated yolk with specific amounts of lysophospholipids. The composition additionally contains phytosterols shown in claim 5. The chain

length of the fatty acid residues in the diglycerides required in claim 8 would be expected from common or typical edible fatty acids. The pH of the product would have been an inherent property of the composition and is disclosed at page 7, lines 1-9. The claims appear to differ from Kawai application in the recitation of the inclusion of a soybean polysaccharide in the Kawai emulsion. Kawai application teaches at page 6, lines 11-15 the addition of a thickened polysaccharide to the emulsion. Nomura further describes polysaccharide for enhancing the stability of the emulsion. It would have been obvious to one of ordinary skill in the art to utilize polysaccharide in the claimed emulsion to enhance the stability of the product. It is appreciated that soy polysaccharide is not mentioned but no unobvious or unexpected result is seen from the selection of one polysaccharide source over another.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be

overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 1-2, 8-15 & 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura (5,160,759) in view of Van Dam (4,119,564).

Nomura discloses an edible oil in water emulsion containing 10 to 99% diglycerides. The chemical structure of the monoglycerides and diglycerides is shown at column 3, lines 19-28. The extent of unsaturation of the fats is shown at column 3, lines 63-68. Both phospholipids and lysophospholipids are used as emulsifiers in the product (column 6, lines 7-28) and it is well known in the art that egg yolk is an excellent source of phospholipids and lysophospholipids (see Van Dam at column 2, lines 48-57). Although pH and viscosity are not shown in the patent, these are inherent properties to the compound of the reference. No unobvious or unexpected difference is seen from the pH and viscosity of the present emulsion. Polysaccharides are emulsions stabilizers in Nomura at column 4, lines 63-65. The claims appear to differ from Nomura in the recitation of the inclusion of soybean polysaccharides. No obvious or unexpected

result is seen from the selection of polysaccharides from soybeans. It would have been obvious to one of ordinary skill in the art to utilize the emulsion of Nomura as the emulsion of the claims.

Claims 18 & 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398 or by dialing 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is

available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Carolyn Paden
CAROLYN PADEN 10-6-05
PRIMARY EXAMINER 1761